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3/8/00  
F. Meier  
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
In Re Application of

Woodward et al

Serial No: 08/876,937

Filed: June 16, 1997

For: NON-ACIDIC CYCLOPENTANE  
HEPTANOIC ACID, 2-CYCLOALKYL  
OR ARYLALKYL DERIVATIVES AS  
THERAPEUTIC AGENTS

Group Art Unit: 1621

Examiner: P. O'Sullivan

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BOARD OF PATENT APPEALS  
AND INTERFERENCES

Honorable Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**RESPONSE TO FINAL REJECTION UNDER 37 CFR § 1.113**

Dear Sir:

At the oral interview of October 13, 1999 regarding the present application, the Examiner stated that the applicants had not responded to the Examiner's request to file a declaration under 37 CFR 1.608(b). Applicants wish to point out that 37 CFR § 1.608(b) requires the filing of such declaration only "when the effective filing date of an application is more than three months after the effective filing date of a patent..." The patent to Bishop et al, i.e. U.S. Patent Number 5,510,383 was filed on August 3, 1993. The priority date of the present application is September 21, 1992, i.e. the present application ultimately depends U.S. patent Application 948,056, now U.S. Patent Number 5,352,708 (the '708 Patent). In particular, the present application, as it relates to the single compound that the Examiner has agreed to declare an interference on, predates the filing date of the patent in question. See Tables 4 and 5 of Columns 13 and 14 of the '708 Patent wherein 16-m-chlorophenoxy PGF<sub>2α</sub> is disclosed as useful for

lowering IOP. (Note 16-m-chlorophenoxy PGF<sub>2α</sub> is cyclopentane heptenoic acid, 5-cis-2-(3-α-hydroxy-4-m-chlorophenoxy-1-trans-butenyl)-3,5-dihydroxy, [1α, 2β, 3a, 5a], which is the compound of the interference. Therefore, the applicants are not required to file a declaration under 37 CFR 1.608(b).

Respectfully submitted,



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CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL IN AN ENVELOPE ADDRESSED TO: BOX APPEAL BRIEF COMMISSIONER OF PATENTS AND TRADEMARKS, WASHINGTON, D.C. 20231 ON 12/2/1999

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